

### **Remarks/Arguments**

Applicants have received and carefully reviewed the Office Action of the Examiner mailed April 17, 2008. Currently, claims 1-46 remain pending of which claims 17-21 and 38-43 were previously withdrawn. Claims 1-16, 22-31, 33-37, and 44-46 have been rejected and claim 32 has been objected to. Favorable consideration of the following remarks is respectfully requested.

### **Claim Rejections – 35 USC § 103**

Claims 1-3, 5-15, 22-31, 33-37, and 44-46 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ramee et al. (U.S. Patent No. 6,203,561), hereinafter Ramee, in view of Cryer et al. (U.S. Patent No. 6,290,710), hereinafter Cryer, and in further view of Boyle et al. (U.S. Patent No. 6,537,294), herein after Boyle. After careful review, Applicant must respectfully traverse this rejection.

“All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). (MPEP § 2143.03). Nowhere does Ramee, appear to disclose an “elongated tubular member defining a first lumen, having a proximal and a distal end, adapted to receive the elongated wire and a second, generally parallel lumen having proximal and distal ports, adapted to receive the guidewire” or “a guide tip having a proximal portion and a distal portion, the guide tip defining a guidewire lumen therethrough adapted to receive and slidably pass a guidewire”. The Examiner has offered Cryer, said to provide a guide tip having a lumen for receiving the guidewire, and Boyle, said to provide a delivery sheath defining two lumens wherein one lumen receives a guidewire and the other lumen receives an elongated wire with a filter; however Ramee has only a single lumen for a single guidewire bearing a fixed nose cone (62) and a filter (52 and 57) and has no need for a guidewire lumen other than the one that bears the filter(s) or for a “guide tip defining a guidewire lumen therethrough adapted to receive and slidably pass a guidewire” as a nose cone that slides along guidewire (63) would not be expected to be reliably displaced to provide room for filter (57) to expand. Further, were the nose cone of Ramee depicted in the cited Fig. 1 to be modified to be slidable relative to guidewire

(63) , it would appear to be readily released into the blood stream with potentially negative results. Further, it appears unreasonable to incur additional cost, bulk, and complexity by adding a second unused lumen of Boyle to Ramee's device, for a nonexistent second guidewire.

Additionally, nowhere does Ramee appear to disclose a filter system "wherein, when the embolic protection filter is collapsed in part within the distal sheath, a portion of the guidewire within the second lumen of the elongated tubular member adjacent the distal port of the second lumen, a portion of the guidewire within the guidewire lumen of the guide tip, a portion of the elongated wire within the first lumen of the elongated tubular member adjacent the distal end of the first lumen, and the point of attachment of the elongated wire to the guide tip are generally coplanar". Neither Boyle nor Cryer appear to remedy the shortcomings of Ramee in this regard. The guidewire of either of Figs. 9 and 10 of Boyle, the only embodiments which appear to employ an obturator, the structure of Boyle most nearly analogous to the guide tip of the pending application which terminates an elongated wire and passes a guidewire, does not pass through the elongated tubular body and so cannot teach or disclose the necessary relationship. Similarly, the only embodiments of Cryer which appear to disclose the required distally opening sheath, those of Figs 7 and 8, employ a single guidewire (66) and a separate distal sheath having a single lumen and no structure resembling a guide tip having a lumen therethrough. Therefore, Ramee in view of Cryer and in further view of Boyle does not appear to teach all the claim limitations, as is required to establish a *prima facie* case of obviousness. Therefore, for at least these reasons, Applicants respectfully assert that there is no motivation to combine the teachings of Ramee, Cryer, and Boyle and request the withdrawal of the rejections of independent claims 1 and 37.

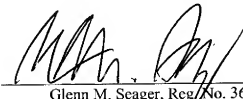
If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). (MPEP 2143.03) Accordingly, Applicants respectfully request the withdrawal of the rejections of claims 2, 3, 5-15, 22-31, 33-36, and 44-46 which depend from independent claims 1 and 37 respectively and add significant additional limitations thereto.

In view of the foregoing, all pending claims are believed to be in a condition for allowance. Reexamination and reconsideration are respectfully requested. Issuance of a Notice of Allowance in due course is anticipated. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

Date:

June 12, 2003



Glenn M. Seager, Reg. No. 36,926  
CROMPTON, SEAGER & TUFTE, LLC  
1221 Nicollet Avenue, Suite 800  
Minneapolis, Minnesota 55403-2420  
Tel: (612) 677-9050